REMARKS

Claim 6 is pending in this application, all other claims having been canceled. Claim 6 was indicated as allowable over two years ago, in an Office Action dated February 3, 2004. Claim 6 has now been rejected under 35 U.S.C. § 102(e), for reasons newly-asserted by the Examiner – i.e., the Examiner now finds that claim 6 is anticipated under section 102 by U.S. Patent No. 6,748,385 (Rodkin).

Initially, applicants note that withdrawing a previous finding of allowability in order to reject a claim based on a newly-discovered reference is highly unusual and is disfavored. In particular, MPEP 706.04 states:

> Full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something.

And MPEP 706.07 states:

> Before final rejection is in order a clear issue should be developed between the examiner and applicant. ... Switching ... from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will ... tend to defeat attaining the goal of reaching a clearly defined issue for an early termination ...

While applicants recognize the need to ensure that available art is fully considered, the discovery of Rodkin does not provide any substantive basis to withdraw the prior indication of claim 6's allowability. Rodkin is clearly distinguishable from claim 6, for the reasons set forth below.

Turning, now, to the substance of the rejection, Rodkin does not teach or suggest the features of claim 6. In order to understand the novelty of claim 6, applicants briefly summarize the teachings of the present application, although it should be noted that neither the examples provided in the application, nor applicants' summary of those teachings below, should be viewed as limiting the claims to the examples provided or summarized.

In general, the application describes a system in which a user can obtain content, such as an electronic book. The content may come in an encrypted form, and may need to be decrypted. The ability to decrypt the content may come through a series of licenses and

chained cryptographic keys. In one example: a license is needed to decrypt the content; the license contains the decryption key for the content, but the key is, itself, encrypted with a certificated public key, and thus requires a particular private key in order to be decrypted. The combination of this public and private key is provided in something that the present application refers to as an "activation certificate." The activation certificate (or a portion thereof) may, in turn, be encrypted with a device key (or with a portion of a device key pair), so that the activation certificate cannot easily be transferred from one machine to another. That way, the number of copies of the activation certificate (and, thus, the number of devices on which the user can ultimately use the content), can be limited, since the activation certificate is given out by an activation server, which encrypts the certificate with the device key before installing the certificate on the device. In one example provided in the application, the activation server initially allows the activation certificate to be installed on five machines, and then allows the activation certificate to be installed on an additional machine after the passage of each ninety-day period. It should be understood, however, that this example is simply an example of a time-dependent function that can be used to limit the number of machines on which the activation certificate can be installed. It should also be understood that the "activation certificate" is typically associated with a particular user; thus, each user can install a representation of his/her activation certificate on, say, up to five machines associated with that user, and another user would be able to install five copies of the (different) activation certificate associated with that (different) user. Moreover, it will be understood that the limit on the number of copies of the activation certificate that can be installed can be a "per-user" limit.

With this background, it should be noted that the "content" described above is an example of the "digital work" recited in claim 6; that the "activation certificate" described above is an example of the "second data" recited in claim 6; and that the number of machines on which "activation certificate" can be installed is an example of the "limit" recited in claim 6.

Neither the applied portions of Rodkin, nor any others that applicants have been able to identify, teaches or suggests the features of claim 6. Rodkin describes the updating of content, and does not appear to describe any "limit" on which some piece of "second data" (such as the activation certificate described in one of the examples of the present application)

can be provided. In Rodkin, content that is to be made available through the Web is assigned an arbitrary character string identifier. There is a correspondence between character strings and destination addresses, such that content servers can direct a web request to a destination address (i.e., the place where the underlying content is located) based on which character string is provided in the request, but the correspondence between character strings and destination addresses can be changed periodically. To facilitate this change, the relationship between the string and the destination address can be assigned an expiration date, at which point the content server will consider the destination address for the assigned to a string to be invalid, and must then query a central server in order to find the valid destination address. The rejection of claim 6 appears to confuse the concept of an expiration date (as in Rodkin), with a limit that restricts the rate at which a user may enable new devices to use digital content, as in claim 6.

In applying Rodkin, the Examiner has cited the following portions of Rodkin: col. 13, ll. 16-31; col. 13, l. 62 through col. 14, l. 14; and col. 22, ll. 58-64. Applicants will demonstrate below why the applied portions of Rodkin do no teach or suggest the features of claim 6.

Col. 13, ll. 16-25 of Rodkin describes the use of a web browser to obtain an on-line article. This portion of Rodkin is cited against the part of claim 6 that refers to a "digital work," and thus it is assumed that the Examiner has read the "digital work" of claim 6 onto the "on-line article" of Rodkin. The Examiner next cites col. 13, ll. 26-31 of Rodkin against the portion of claim 6 that recites that the digital work calls for the presence of "second data" in order to be used on a computing device; this applied portion of Rodkin refers to "character strings and corresponding destination addresses." It is assumed that the Examiner regards the "character strings and corresponding destination addresses" as being the "second data" needed to view an on-line article; applicants note that Rodkin does not state that the "character strings and corresponding destination addresses" need to be present on the computing device on which a digital work is being used, as called for in claim 6. The fact that this feature is not present in Rodkin is sufficient to demonstrate that claim 6 is not anticipated by Rodkin.

However, even if one overlooks Rodkin's silence on the above-described feature, applicants note that – in order for claim 6 to read on Rodkin – Rodkin would have to show

that there is some limit that governs whether character strings and destination addresses are provided to the machines on which on-line articles will be used, and, moreover, that this limit is a time-dependent number that is the sum of (1) a first number, and (2) the product of a second number and a third number. No such feature is taught or suggested by Rodkin. In order to show these features, the Examiner cites col. 22, ll. 58-64 of Rodkin, which discusses the idea that destination addresses can have expiration dates – i.e., at some point, the destination address associated with a particular piece of content may expire, and the content server may have to contact a central server to determine what destination address currently corresponds to a piece of content. However, even if one assumes that the "destination address" is (or is part of) the "second data" in claim 6, Rodkin's expiration date does not limit how often a destination address can be provided. Rather, the expiration date is more the *opposite* of such a limitation, since it specifies that the destination address should be refreshed at least by a certain date (but does not preclude the possibility that the address could be refreshed more often). By contrast, a user who wants to be provided with "second data" when the limit of claim 6 is exceeded would not receive the second data (at least until passage of sufficient time occurs, in accordance with the formula described in claim 6). Furthermore, even if the expiration date in Rodkin could be considered to correspond to the limit recited in claim 6, there is no indication that the date in Rodkin is the sum of (1) a first number, and (2) the product of a second number and a third number.

Moreover, claim 6 recites that the limit allows five devices to be enabled within a first ninety days, plus an additional device for each subsequent ninety-day period. The Examiner notes that, at col. 14, l. 8, Rodkin happens to mention ninety-days as an example expiration period. However, Rodkin does not mention that use of an additional device can be allowed for each subsequent ninety-day period.

For the reasons explained above, Rodkin does not teach or suggest the features of claim 6. Applicants thus request that the section 102 rejection of claim 6 be reconsidered and withdrawn.
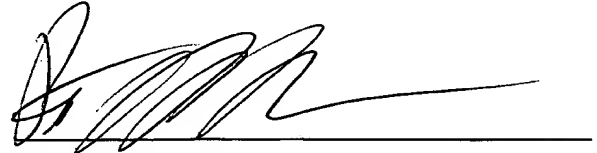
<u>Conclusion</u>

Applicants respectfully submit that this case is in condition for allowance. Rodkin provides no reason to question the allowability of claim 6, so applicants request that the Examiner restore decision of allowability that was previously made.

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